

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appln. Ser. No.:	Filed:	Inventor(s):	Atty Dkt:
09/914,744	4 September 2001	Y. ONO et al.	114GI-149
Title: Magnetic Substance with Maximum Complex Permeability			
Examiner: C.M. Koslow		Art Unit: 1755	

Asst. Comm'r for Patents
Washington, D.C. 20231-0001

4 Pages Total VIA FACSIMILE
703-872-9310

REPLY TO ELECTION REQUIREMENT
and Amendment
and Petition for Extension of Time

Dear Sir:

In complete response to the Office action mailed 4 February 2003, in which an election of various species was required, which requirement is respectfully traversed, Applicants hereby elect species 10, a thin film composite where grains of M are distributed in a sputtered matrix consisting of X and Y, and the species of M, X, and Y wherein M is Fe, X is Al, and Y is O. Claims 1 to 12 and 14-16 read on these elections.

A petition for extension of time is provided at the end of this paper.

Please amend the subject application as follows, the amendment being shown in marked-up form in the attached appendix following this paper.

IN THE CLAIMS:

13. The magnetic substance according to claim 1, wherein said magnetic composition is a composition represented by a formula of $\text{Fe}_x\text{-Si}_y\text{-O}_z$.

REMARKS

Entry of the foregoing amendment is respectfully requested. This amendment is made to correct an obvious error. As presented in the Preliminary Amendment filed previously, claims 12 and 13 were identical. Claim 13 is now amended to recite the composition (with Si) as was recited in original claim 12.

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and with the dependency changed as in the Preliminary Amendment. No new matter is presented.

Election of Species Requirement

The allegation that claim 1 fails to recite a single inventive concept under PCT Rule 13.1 is contradicted by the existence of Markush practice in the Office. MPEP 803.02 and 2173.05(h): "*Ex parte Markush* sanctions claiming a genus as a group consisting of certain specified materials" The single inventive genus of this application is recited as claim 1, in spite of the alternative language. Therefore, the statement that there is no generic claim is clearly incorrect; claims 1-13 form a single inventive concept, and only to the extent that the structure imparted by the type of method of or article of manufacture, as recited in claims 14-16, *might* be patentably distinct (and such is neither conceded nor alleged) are there other species that might be independent.

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Further

If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803.02.

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MPEP 803.02 states that unity of invention exists where (i) the compounds recited in the Markush group share a common utility and (ii) share a substantial structure feature disclosed as being essential to that utility. In this case, all of the compounds, the M-X-Y compositions, have the physical properties recited in claim 1, which properties exist in the recited compounds having the M-X-Y composition (or structure).

Moreover, because this application is a U.S. national stage application of a PCT application, MPEP 1893.03(d) sets forth the standard for unity of invention and makes reference to Annex B of the PCT administrative regulations. As stated in Annex B, Part 1(f)(i), there is unity where all of the compounds (the

claimed M-X-Y compositions) (i) have a common property, here the common properties are specifically recited in claim 1, and (ii) form an art-recognized class of chemical compounds, meaning that "there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention." Part 1(f)(i)(B)(2) and 1(f)(iii). Note also Examples 16 and the examples under Part 2(III) ("Markush practice") of Annex B.

Accordingly, the alleged lack of unity is incorrect and should be withdrawn.

Petition for Extension of Time

Pursuant to the provisions of 37 CFR 1.136(a), Applicants hereby petition for a one month extension of time to 4 April 2003 in order to respond to the Office Action dated 4 February 2003 setting forth a one month date for response.

Please charge the \$ 110.00 fee under § 1.17(a)(1), and any other fees under 37 C.F.R. § 1.16 or § 1.17 necessitated by this paper, to Deposit Account No. 502144.

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Respectfully submitted,

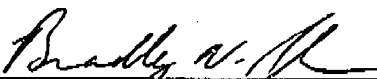
**CERTIFICATE OF MAILING OR
TRANSMISSION – 37 CFR 1.8**

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: 4 APRIL 2003

NAME: Brad Ruben

SIGNATURE: Brad Ruben


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APPENDIX SHOWING MARK-UPS OF AMENDMENTS**IN THE CLAIMS:**

13. The magnetic substance according to claim 1, wherein said magnetic composition is a composition represented by a formula of $[\text{Fe}_\alpha\text{-Al}_\beta\text{-O}_\gamma]$ $\text{Fe}_\alpha\text{-Si}_\beta\text{-O}_\gamma$.